

REMARKS

Status of the Claims

Claims 34-35, 37-40, 42-44, 46, 49-51, 54, 56-58, and 60-61 are pending in the present application, Claims 1-33, 36, 41, 45, 47, 48, 52, 53, 55, and 59 having been previously canceled. No amendments are presented herein.

Claims Rejected Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 34, 35, 37-40, 42-44, 46, 49-51, 54, 56-58, and 60-61 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,981,956 (Stern) in view of U.S. Patent No. 6,249,341 (Basiji et al. – hereinafter referred to as “Basiji”).

Applicants respectfully submit that the Basiji reference **IS NOT** prior art with respect to the pending application. The Examiner has admitted that Stern fails to teach each element recited in the claims (i.e., Stern was not used as the basis for a rejection under 35 U.S.C. § 102). Without Basiji providing the elements not disclosed by Stern, a *prima facie* case of obviousness cannot be supported. The Basiji reference **IS NOT** prior art for the following reasons.

The following facts are significant. The inventorship between the Basiji reference and the pending application is identical (William Ortyn and David Basiji). The pending application has an effective filing date of February 21, 2001 (the filing date of the provisional application to which the present application claims priority). Both the provisional application and the pending application specifically incorporate by reference the disclosure and drawings of U.S. Patent No. 6,249,341. The Basiji reference and the pending application are commonly assigned to Amnis Corporation. Clearly, the Basiji reference represents applicants' own disclosure.

The Basiji reference is not prior art as applied to the pending application under 35 U.S.C. § 102(a), because: (1) the Basiji reference is not *by another* (the Basiji reference is applicants' own disclosure); and, (2) the effective filing date of the pending application (February 21, 2001) is before the issue date of the Basiji reference (June 19, 2001). The provisional application includes 20 of the 21 Figures in the pending conventional application. The provisional application provides a brief description of those Figures, whereas the present conventional application provides a more detailed description. However, the provisional application clearly discloses the core concepts of the technology being claimed. Significantly, the provisional application provides a relatively brief description of the preferred imaging system, some aspects of

1 which are relevant to the pending claims. Moreover, the provisional application specifically
2 incorporated by reference the Basiji reference (which was a pending patent application at the time of
3 the filing of the provisional application, and which describes in detail the preferred imaging system),
4 thus applicants clearly were in possession of those concepts at the time the provisional application
5 was filed. Because the provisional application provides support for the elements recited in the
6 pending claims, those claims are afforded the effective filing date of the provisional application, and
7 the Basiji reference is not prior art.

8 The Basiji reference is not prior art as applied to the pending application under
9 35 U.S.C. § 102(b), because while the Basiji reference corresponds to applicants' own disclosure, the
10 Basiji reference does not precede the filing of the pending application by more than a year (indeed, as
11 discussed above, the Basiji reference was not published until *after* the provisional application was
12 filed).

13 The Basiji reference is not prior art as applied to the pending application under
14 35 U.S.C. § 102(c), because the Basiji reference does not support a conclusion that applicants have
15 abandoned their invention.

16 The Basiji reference is not prior art as applied to the pending application under
17 35 U.S.C. § 102(d), because the Basiji reference does not support a conclusion that applicants had
18 previously filed a foreign application claiming the same invention a year before filing the pending
19 application.

20 The Basiji reference is not prior art as applied to the pending application under
21 35 U.S.C. § 102(e), because the Basiji reference is not *by another*.

22 The Basiji reference is not prior art as applied to the pending application under
23 35 U.S.C. § 102(f), because the Basiji reference does not support a conclusion that applicants are not
24 the inventors of the pending claims.

25 The Basiji reference is not prior art as applied to the pending application under
26 35 U.S.C. § 102(g), because the Basiji reference does not relate to an interference proceeding.

27 Clearly, the Basiji reference is not prior art under any provision of the patent law. As noted
28 above, without Basiji providing the elements not disclosed by Stern, a *prima facie* case of
29 obviousness cannot be supported. Accordingly, the rejection of Claims 34, 35, 37-40, 42-44, 46, 49-
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1 51, 54, 56-58, and 60-61 under 35 U.S.C. § 103(a) as being unpatentable over Stern in view of Basiji
2 should be withdrawn.

3 The Examiner is thus requested to pass the present application to issue in view of the remarks
4 submitted above. If there are any questions that might be addressed by a further telephone interview,
5 the Examiner is invited to telephone the undersigned attorney, at the number listed below.
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10 Respectfully submitted,
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14 Michael C. King
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